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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,511	11/10/1999	HANS SJOBLUM	003300-592	6824

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BENTON S DUFFETT JR  
BURNS DOANE SWECKER & MATHIS  
PO BOX 1404  
ALEXANDRIA, VA 223131404

EXAMINER

WANG, MARY DA ZHI

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 04/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/423,511

Applicant(s)

SJOBLOM, HANS

Examiner

Mary Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites, "characterised in that it is of a so-called advanced type". It is not clear what the word "it" refers to.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-9, 11-13, 15-18, 21-23 and 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Barlow et al., U. S. Patent 6,038,551.

As to claim 1, Barlow teaches a method for performing electronic transactions, in which a sender of transaction messages is assigned a smart card with an associated unique identity and a private key stored in the card in a protected manner, and in which an associated public key is kept generally available, characterised in that in connection with an electronic transaction under the sender's own control, preferably through his own input of message information, the sender creates a transaction message, which contains information necessary for the transaction, and in his smart card, provides the created transaction message with his digital signature while using his own private key

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for subsequent output and transmission of the transaction message (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 2, Barlow teaches characterised in that the transaction message contains information on sender, receiver, amount and preferably a transaction serial number (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claims 3-4, Barlow teaches the transaction message is created off-line (column 14 line 61 – column 15 line 10).

As to claim 5, Barlow teaches characterised in that the transaction message is created in the smart card (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 6, Barlow teaches characterised in that the transaction message is created with the aid of software inserted in the smart card in advance and preferably also sender information inserted in the card in advance (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 7, Barlow teaches characterised in that information required for the transaction message is input with the aid of input means arranged on the smart card, the card preferably being also-called advanced smart card (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 8, Barlow teaches characterised in that information necessary for the transaction message is input with the aid of a protected card terminal (column 15 lines 47-52 and Figs. 3-5).

As to claim 9, Barlow teaches characterised in that information necessary for the transaction message is input with the aid of a separate card communication unit, the latter preferably also being a card activator (Figs. 1-2).

As to claim 11, Barlow teaches characterised in that the transaction message contains sender information in the form of at least one of the following pieces of information: a card number, a cash card number, a charge card number, a credit card number, an account number, an invoice number and an ID number (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 12, Barlow teaches characterised in that the transaction message contains receiver information in the form of at least one of the following pieces of information: a card number, a cash card number, a charge card number, a credit card number, an account number, an invoice number and an ID number (column 14 lines 5-61 and Figs. 3, 5, 7-12).

As to claim 13, Barlow teaches characterised in that the signed transaction message is sent to a card or account administrator regarding the sender or receiver, that the digital signature of the transaction message is authenticated by using the public key, which is assigned to the one who is identified as sender by the transmitted transaction message, and that in case of authenticity, the receiver is credited with the transaction amount by a clearing process (column 14 lines 5-61 and Figs. 3, 5, 7-10).

As to claim 15, Barlow teaches characterised in that the signed transaction message is encrypted by using a public key belonging to the addressee, to whom the transaction message is sent, that the encrypted, signed transaction message is sent to

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the addressee, that the addressee by using his private key decrypts the signed transaction message, that the digital signature of the transaction message is authenticated by using the public key which is assigned to the one who is identified as sender by the transmitted transaction message, and that the receiver, in case of authenticity, is credited with the transaction amount by a clearing process (column 14 lines 5-61 and Figs. 3, 5, 7-12).

As to claim 16, Barlow teaches characterised in that the addressee is the receiver, that the receiver, after decryption, sends the signed transaction message to a card or account administrator, whereupon said authentication takes place (column 14 lines 5-61 and Figs. 3, 5, 7-12).

As to claim 17, Barlow teaches characterised in that the signed transaction message is encrypted by using the sender's public key and is provided with sender information and is then sent to a card or account administrator, who has the sender's private key and who preferably has issued the user's smart card, that said administrator decrypts the received encrypted message by using said private key, that authentication of the digital signature of the decrypted transaction message takes place by using the public key, which is assigned to the one who is identified as sender by the transmitted transaction message, and that the receiver, in case of authenticity, is credited with the transaction amount by a clearing process (column 14 lines 5-61 and Figs. 3, 5, 7-12).

As to claim 18, Barlow teaches characterised in that the signed transaction message is sent non-encrypted, especially via a public communications network, such as the Internet or a telecommunications network (column 15 lines 11-17).

Claims 21, 23 and 26 are rejected for the similar reasons as claims 1 and 13.

Claims 22 and 28 are rejected for the similar reason as claim 7.

Claim 25 is rejected for the similar reason as claim 9.

Claims 27 and 29 are rejected for the similar reason as claims 3-4.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barlow et al., U. S. Patent 6,038,551.

As to claim 14, Barlow teaches the signed transaction message is first sent to the receiver (column 14 lines 5-61 and Figs. 3, 5, 7-10). Barlow does not specifically teach optionally forwards the signed transaction message to said card or account administrator. It would have been obvious to one of ordinary skill in the art to allow the system of Barlow to include the feature of forwarding the signed transaction message to his/her smart card or account administrator so that the transaction can be better tracked.

10. Claims 10, 19-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barlow et al., U. S. Patent 6,038,551 in view of Heinonen et al., U. S. Patent 5,887,266.

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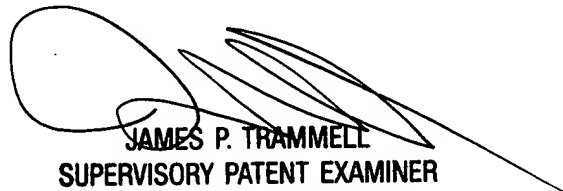
As to claims 10, 19-20 and 24, Barlow does not specifically teach the telecommunication unit is a mobile telecommunication unit such as mobile phone. However, Heinonen teaches a mobile telecommunications unit such as a mobile phone controlled by the smart card and SMS service is used for communicating data message (column 1 lines 11-37 and column 2 lines 17-42 and column 3 lines 1-10 and Fig. 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the telecommunication unit of Barlow to include features as taught by Heinonen so that user can remotely transmit or access messages.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carlisle et al. (U. S. Patent 5,649,118) discloses a consumer items may be purchased by debiting any of a plurality of accounts stored on a smart card.

Fischer (European Patent 0 624 014 A2) discloses a personal date/time notary device is embodied in a smart card as shown in Figure 1.



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

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***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Wang whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 746-7238 (After Final Communication)

(703) 746-7239 (Official Communications)

(703) 746-7240 (For Status inquiries, draft communication)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3900.

Mary Wang  
Patent Examiner  
Art Unit 2161  
March 29, 2002